

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 05-1128-A1)

In the Application of:)
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 Richard Martin) Examiner: Brenda Libby Coleman
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Application No.: 10/565,702) Art Unit: 1624
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Filing Date: September 13, 2006) Confirmation No.: 2568
)
For: Azepine Derivatives as Pharmaceutical)
 Agents)

PETITION UNDER 37 CFR 1.181 TO WITHDRAW FINALITY OF REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The applicants petition to withdraw the finality of the Office Action mailed May 19, 2011, because it was improper.

The applicants submit that the examination procedure employed was improper, being inconsistent with the legal requirements set out in MPEP § 706.07(a), which states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT

CERTIFICATE OF TRANSMISSION (37 C.F.R. 1.8)

I hereby certify that this correspondence is being transmitted to the USPTO via the USPTO EFS on July 19, 2011.

Date: July 19, 2011

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make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

(Emphasis added.) The Applicants submit that, according to MPEP § 706.07(a), a second or a subsequent action on the merits cannot be made final if it includes a new ground of rejection (for example, a rejection based on newly cited art) that is necessitated neither by Applicant's amendment of the claims nor by information submitted in an IDS.

In the currently pending final Office Action the Office issued two rejections on new grounds, neither of which were necessitated by the Applicant's claim amendments. In particular, the Office issued a new rejection under 35 USC § 102 citing new prior art (Janssen *et al.*). In fact, this is the first prior art rejection that has been issued in this application. This art was not cited in an IDS, nor was it necessitated by the previous amendments. And, furthermore, it in fact does not anticipate the claims as explained in the concurrently-filed response.

The Office also issued a rejection under 35 USC § 112, first paragraph, raising issues that were not previously raised. Previously, the Office rejected claims 1-5 and 32-48 for lack of enablement for the terms "solvates", "polymorphs", and "prodrug", and claims 32-42, 44, and 48, for lack of enablement for the terms "esters", "enol ethers", etc. In response to these rejections, Applicants amended the claims to remove these terms resulting in the claims with reduced scope. In this Action, the Office issued a new enablement rejection based on the definitions of X, Y, Z, R¹, etc. This enablement rejection was not previously raised and not necessitated by the claim amendments as the same definitions of X, Y, Z, R¹, etc., as presently pending were previously pending.

In view of both newly cited § 102 art and new grounds of rejections under 35 USC § 112, Applicants respectfully request that the finality of the pending Action be withdrawn. Applicants simultaneously submit herewith a petition to the technology center Director for withdrawal of the finality of this action.

The applicants also request that any prosecution delays otherwise attributable to the applicant resulting from the improper imposition of the final Office Action be attributed to the Patent Office and that all extension of time fees necessitated by the improper imposition of the final Office Action be refunded to deposit account no. 13-2490.

If there are any questions or comments regarding this application, the Examiner is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

Date: July 19, 2011

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